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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/075,932	02/14/2002	Donald Spector	F.4021-115.1	2766
27957	7590	09/16/2004	EXAMINER	
DICKSTEIN SHAPIRO MORIN & OSHINSKY LLP 1177 AVENUE OF THE AMERICAS NEW YORK, NY 10038-2714			HANNE, SARA M	
			ART UNIT	PAPER NUMBER
			2179	

DATE MAILED: 09/16/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/075,932

Applicant(s)

SPECTOR, DONALD

Examiner

Sara M Hanne

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

DETAILED ACTION***Claim Objections***

1. Claim 4 is objected to because of the following informalities: the limitation "substrate in selected from the group of ..." in lines 1-2 of Claim 4, page 13, appears to be a typographical error. It is believed that the intended limitation should read "substrate is selected from the group of ..." Appropriate correction is required.

Double Patenting

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 1-11 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-6 of U.S. Patent No. 6356274. Although the conflicting claims are not identical, they are not patentably distinct from each other because the subject matter claimed in the instant application is fully disclosed in the referenced application and is claiming common subject matter as follows:

As in Claims 1 and 9 of the application, A computer system and method for converting a colored picture or designs composed of color and non-colored regions distributed throughout the picture into a line drawing in which each of said regions is delineated to define a zone and reproducing the line drawing on a substrate, comprising a computer provided with a video display terminal, a printer coupled to the display terminal to print out on a sheet an image displayed on the terminal, means to feed into the computer a digital image of the picture or design to be converted, software associated with the computer to process the digital image to produce the line drawing which is displayed on the terminal and printed on the sheet whereby a user of the system, by coloring in the zones, can recreate a colored picture or design, and further means for transferring the digital image to a substrate (printing includes transferring the digital image to a substrate, the substrate being the paper. See Claim 1 of the referenced patent).

As in Claim 2 of the application, a collection of colored and non-colored picture and designs are digitally stored in software, the user selecting for conversion one of said pictures for preparation of a line drawing for transfer to a substrate (Claim 2 of the referenced patent).

As in Claim 3 of the application, the line drawing is converted to a stencil whereby some of line drawing can be reproduced onto various substrate (Column 4, lines 38-44).

As in Claim 4 of the application, the substrate is paper (Claim 1 of the referenced patent).

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As in Claim 5 of the application, means to identify each zone with a symbol that indicates the color to be applied thereto (Claim 3 of the referenced patent).

As in Claim 6 of the application, a color separator to separate the color regions of which the picture is composed into partial images having a Common color (Claim 4 of the referenced patent).

As in Claim 7 of the application, the common color is an elementary color in the color spectrum or a color similar thereto (Claim 5 of the referenced patent).

As in Claim 8, of the application a line filter to delineate the separated color regions (Claim 6 of the referenced patent).

Claims 10-11 are rejected on their dependency upon Claim 9.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 1-3 and 5-9 are rejected under 35 U.S.C. 102(e) as being anticipated by Lockeridge et al., US Patent 6727906.

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As in Claims 1 and 9 of the application, Lockeridge et al. teaches a computer system and method comprising a computer provided with a video display terminal (Figure 10, ref. 1016), a printer coupled to the display terminal to print out on a sheet an image displayed on the terminal (Column 9, lines 11-12), means to feed into the computer a digital image of the picture or design to be converted (Column 2, lines 1-5), software associated with the computer to process the digital image to produce the line drawing which is displayed on the terminal and printed on the sheet (Column 9, lines 9-12) whereby a user of the system, by coloring in the zones, can recreate a colored picture or design (Column 9, lines 15-18), and further means for transferring the digital image to a substrate (printing includes transferring the digital image to a substrate)

As in Claim 2 of the application, Lockeridge et al. teaches a collection of colored and non-colored picture and designs are digitally stored in software, the user selecting, for conversion, one of the pictures for preparation of a line drawing for transfer to a substrate (Column 4, line 6 et seq.).

As in Claim 3 of the application, Lockeridge et al. teaches the line drawing is converted to a stencil whereby some of line drawing can be reproduced onto various substrate (Figure 9 and corresponding text).

As in Claim 5 of the application, Lockeridge et al. teaches means to identify each zone with a symbol that indicates the color to be applied thereto (Column 8, lines 64-67).

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As in Claim 6 of the application, Lockeridge et al. teaches a color separator to separate the color regions of which the picture is composed into partial images having a Common color (Column 8, lines 35-37).

As in Claim 7 of the application, Lockeridge et al. teaches the common color is an elementary color in the color spectrum or a color similar thereto (Column 3, lines 30-38).

As in Claim 8 of the application, Lockeridge et al. teaches a line filter to delineate the separated color regions (Figures 8-9).

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claim 4 is rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Lockeridge et al., US Patent 6727906.

It appears that the substrate "paper" is inherently included in Alloul et al. teaching of the "printer" (Column 9, lines 8-14) because printers commonly output on a substrate of paper. Even if it is not, the limitation "paper" is well known. One of ordinary skill in the art would have been motivated to make

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such a combination because a physical outputted product for user manipulation, ie. a user-designed coloring book, would have been obtained.

8. Claims 10-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lockeridge et al., US Patent 6727906, and in further view of Hirabayashi et al., US Patent 6325560.

As in Claim 10, Lockeridge et al. teaches the converting of an inputted color image to line drawing form, altering the colors of the zones of the line drawing and printing it on a substrate. While Lockeridge et al. teaches the image conversion, manipulation and reproduction, they fail to show the T-shirt as the substrate as recited in the claims. In the same field of the invention, Hirabayashi et al. teaches a printer similar to that of Lockeridge et al. In addition, Hirabayashi et al. further teaches a printer capable of reproducing images on a T-shirt substrate. It would have been obvious to one of ordinary skill in the art, having the teachings of Lockeridge et al. and Hirabayashi et al. before him at the time the invention was made, to modify the converting of an inputted color image to line drawing form, altering the colors of the zones of the line drawing and printing taught by Lockeridge et al. to include the T-shirt substrate of Hirabayashi et al., in order to obtain an altered reproduction of a digital image on a T-shirt. One would have been motivated to make such a combination because a customizable personalized piece of clothing would have been obtained, as taught by Hirabayashi et al.

As in Claim 11 Lockeridge et al. teaches the converting of an inputted color image to line drawing form, altering the colors of the zones of the line

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drawing and printing it on a substrate. While Lockeridge et al. teaches the image conversion, manipulation and reproduction, they fail to show the transparency as the substrate as recited in the claims. In the same field of the invention, Hirabayashi et al. teaches a printer similar to that of Lockeridge et al. In addition, Hirabayashi et al. further teaches a printer capable of reproducing images on a transparency substrate. It would have been obvious to one of ordinary skill in the art, having the teachings of Lockeridge et al. and Hirabayashi et al. before him at the time the invention was made, to modify the converting of an inputted color image to line drawing form, altering the colors of the zones of the line drawing and printing taught by Lockeridge et al. to include the transparency substrate of Hirabayashi et al., in order to obtain an altered reproduction of a digital image on a transparency. One would have been motivated to make such a combination because a learning aid for scanned maps or pictures that the teacher may highlight during class would have been obtained, as taught by Hirabayashi et al.

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Conclusion

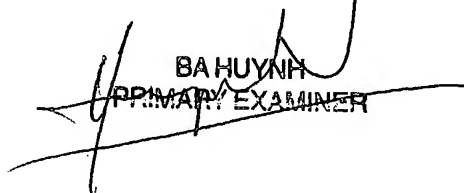
The prior art made of record on form PTO-892 and not relied upon is considered pertinent to applicant's disclosure. Applicant is required under 37 C.F.R. § 1.111(c) to consider these references fully when responding to this action. The documents cited therein teach similar picture reproduction and editing techniques using computers.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sara M Hanne whose telephone number is (703) 305-0703. The examiner can normally be reached on M-F 7:30am-4:00pm, off on alternating Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather R Herndon can be reached on (703) 308-5186. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

smh


BA HUYNH
PRIMARY EXAMINER